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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,449	09/04/2003	Osami Kajimoto	F-7897	8461
28107	7590	05/05/2004	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			MARMOR II, CHARLES ALAN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,449

Applicant(s)

KAJIMOTO ET AL.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/813,906.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This Office Action is responsive to the Preliminary Amendment filed September 4, 2003. The Examiner acknowledges the cancellation of claims 1-15 and the amendment to the Abstract of the Disclosure. Claims 16-27 are pending.

Specification

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

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(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. The specification is objected to because:

a. The arrangement of the specification does not correspond to the preferred layout for

U.S. practice.

b. On page 5, line 6, "causes" apparently should read --cause--.

c. On page 5, line 7, "to" apparently should read --with--.

d. On page 5, line 21, "responses" apparently should read --response--.

e. On page 6, line 3, "show" apparently should read --shows--.

Appropriate correction is required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. Claim 16 is objected to because of the following informalities:

a. In line 8, "for" (second occurrence) apparently should read --by--.

b. In line 10, "for" (first occurrence) apparently should read --by--.

Appropriate correction is required.

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6. Claim 17 is objected to because of the following informalities: in line 2, “allowing” apparently should read “controlling”. Appropriate correction is required.

7. Claim 18 is objected to because of the following informalities: in line 2, “allowing” apparently should read “controlling”. Appropriate correction is required.

8. Claim 19 is objected to because of the following informalities:

- a. In line 3, “allowing” apparently should read “controlling”.
- b. In line 4, “allowing” apparently should read “controlling”.

Appropriate correction is required.

9. Claim 20 is objected to because of the following informalities:

- a. In line 2, “comprise” apparently should read --comprises--.
- b. In line 3, “allowing” apparently should read “controlling”.
- c. In line 4, “when” apparently should be deleted.

Appropriate correction is required.

10. Claim 21 is objected to because of the following informalities:

a. The Examiner inquires whether the three claimed functions are elements of the test apparatus as a whole as claimed, or whether Applicant intended the three functions as part of the image control means.

- b. In lines 2, 5, 8 and 10, “allowing” apparently should read “controlling”.

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c. In line 14, "the test" apparently should read --a test--.

Appropriate correction is required.

11. Claim 24 is objected to because of the following informalities:

a. In lines 3, 6 and 8, "allowing" apparently should read "controlling".

b. In line 3, "erasing" apparently should read --erase--.

Appropriate correction is required.

12. Claim 25 is objected to because of the following informalities: in line 4, "tests" apparently should read --test--. Appropriate correction is required.

13. Claim 26 is objected to because of the following informalities: in line 3, "tests" apparently should read --test--. Appropriate correction is required.

14. Claim 27 is objected to because of the following informalities: in line 2, "the" apparently should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 16-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 16 recites the limitation "the screen" in lines 2-3 and 4-5. There is insufficient antecedent basis for this limitation in the claim. There is no screen recited in the claim prior to these recitations, and it is not inherent that a display must include a screen. This limitation is also recited in claims 21 and 24.

Claim 17 recites the limitation "the dummy targets" in line 3. There is insufficient antecedent basis for this limitation in the claims. There are no dummy targets recited in the claims prior to this recitation.

Claim 18 recites the limitation "the dummy targets" in line 3. There is insufficient antecedent basis for this limitation in the claims. There are no dummy targets recited in the claims prior to this recitation.

Claim 19 recites the limitation "the marks" in lines 3 and 5. There is insufficient antecedent basis for this limitation in the claims. There are no marks recited in the claims prior to this recitation.

Claim 19 recites the limitation "the randomly displayed dummy targets" in lines 8-9. There is insufficient antecedent basis for this limitation in the claims. There are no dummy targets recited in claims 16 or 19 prior to this recitation.

Further regarding claim 19, the excessive use of alternative language in lines 7-9 of the claim makes the metes and bounds of the mark placement vague and indefinite.

Regarding claim 20, the use of the pronoun "its" renders the claim indefinite. One cannot be certain what "its" is intended to refer to, i.e., the display means or each target.

Regarding claim 22, it is unclear how many tests the apparatus comprises. Specifically, the claim indicates that the apparatus includes a plurality of tests; however, claim 21, on which

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claim 22 is dependent, appears to indicate that the apparatus includes only a single test but three functions.

Regarding claim 23, it is unclear how many tests the apparatus comprises. Specifically, the claim indicates that the apparatus includes a plurality of tests; however, claim 21, on which claim 23 is dependent, appears to indicate that the apparatus includes only a single test but three functions.

Claim 24 recites the limitation "the mentation test method" in line 1. There is insufficient antecedent basis for this limitation in the claims. There is no method recited in the claims prior to this recitation.

Claim 24 recites the limitations "the test 2" in lines 2-3 and "the test 3" in line 5. There is insufficient antecedent basis for these limitations in the claims. There is no test 2 or test 3 recited in the claims prior to these recitations.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 16-20 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-188020 (Kiyoshi). Kiyoshi teaches a diagnosis device for nervous function. The device uses an image control means in computer (1) controls a display means to display a randomly distributed given number of targets to be sequentially pointed according to a prescribed order on

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a screen of a display means (figure 7) and measure the search response time required for a test subject to search each target by requesting the subject to sequentially point the targets according to a prescribed order. The mentation of the test subject can be calculated using a processing means within computer (1) based on the measured values. The given number of targets are displayed on a screen of an electronic control display means, and the test subject points the targets by pressing the locations corresponding to the targets on a touch panel (2) overlaid on the screen. The targets may be erased from the screen when they are pointed in a correct order, or dummy targets may be displayed in place of the erased targets at the positions where the erased targets have been located or at random positions when the targets are pointed in a correct order. The color, shape or size of the target may be different from those of the dummy target. The test results are printed by a printer (6).

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 16-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-10, 14, 16 and 17 of U.S. Patent No.

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6,648,834. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application recite an apparatus including structural limitations that are required to perform the method steps of the method of the claims of the patent. It would be obvious to one having ordinary skill in art that the method of Claim 2 of the patent would require a structure including the elements of claim 16 of the instant application in order to be performed. Claims 17-23 of the instant application substantially correspond to claims 4-10 of the patent, respectively. Claim 24 of the instant application substantially corresponds to claim 14 of the patent. Claim 25 of the instant application substantially corresponds to claim 17 of the patent. Claim 26 of the instant application substantially corresponds to claim 16 of the patent. Since the method of claims 2-10, 14, 16 and 17 of the patent would obviously require a structure including the elements of the apparatus of claims 16-26 of the instant application in order to be performed, the claims are not patentably distinct.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ylinen ('759) teaches a device for testing reaction time. Gomez ('637) teaches an apparatus for testing the reflex reaction time of a subject. Ono ('659) teaches an intelligence tester. Fukui et al. ('908) teach an evaluating system for half side vision space misrecognition. Stewart et al. ('739) teach a system for measurement of attention span and attention deficits. Bowles et al. ('417) teach an apparatus for testing users for alertness and mental fitness. Smith ('576) teaches a reaction test.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on (703) 308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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April 30, 2004